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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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29177	7590	02/14/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			ZEWDU, MELESS NMN	
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			2683	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/517,935	Applicant(s) KRISCHKER ET AL.	
	Examiner Meless N. Zewdu	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/19/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-25, 27, 29-33, 35 and 37-40 is/are rejected.
- 7) ☒ Claim(s) 26, 28, 34 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the communication filed on 12/19/05.
2. Claims 1-21 were cancelled in a previous amendment.
3. Claims 22-40 are pending in this action.
4. The previous objection to the specification has been withdrawn in response to the instant amendment.
5. This action is final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-24, 29-32 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablon (WO 99/45687) in view of ITU-T

Recommendation H.245, sections 5.2-5.9; (XP-002199601), hereafter, The **ITU-T Recommendation**.

As per claim 22: The preamble does not further limit the claim, and is considered as an intended use. Regarding the features of claim 22, Yablon teaches:

signaling a call from a second telecommunications device (calling device) of a second telecommunications subscriber to a first telecommunications device of a first telecommunications subscriber (recipient device) (see fig. 16; page 23, lines 10-12). (Fig.16) shows a "Handshake", procedure for establishing a call between a first and a second telecommunication devices (see particularly step 1: Handshake).

transmitting subscriber data from the second telecommunications device to the first telecommunications device in accordance with the device information (see fig. 16; page 23, lines 10-23). (Fig.16, steps 1 and 2) shows that subscriber data/information (device's capability) is determined (1st step) and based on the determination, information is transmitted (2nd step). Furthermore, the first and second devices exchange each other's device information bi-directionally (see fig. 16, 1st and 2nd steps). But, Yablon does not explicitly teach whether or not the information indicates a

type of subscriber data that the first telecommunication device wants to receive, as claimed by applicant. However, in a related field of endeavor, the ITU-T recommendation teaches about a capability exchange wherein “the total capability of a terminal to receive and decode various signals is made known to the other terminal by transmission of its capability set (see entire document, particularly page 1, paragraphs 1-3). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Yablon with the ITU-T Recommendation for the advantage of enabling a transmitting terminal to offer choice of preferred mod to a receiver (see page 1, 3rd paragraph).

As per claim 30: The preamble does not further limit the claim, and is considered as an intended use. Regarding the features of claim 30, Yablon teaches:

signaling a call from a second telecommunications device of a second telecommunications subscriber to a first telecommunications device of a first telecommunications subscriber (see fig. 16; page 23, lines 10-23);

transmitting subscriber data from the first telecommunications device (recipient device) to the second telecommunications device (calling device) in accordance with the device information (see fig. 16; page 23, lines 10-

18). It is shown in (fig. 16, steps 1 and 2) that a calling device and the recipient device exchange information on their respective capabilities (step 1) so as to enable actual transmission of information (subscriber data) (see second step) according to agreed upon protocol. Furthermore, devices' information (capability) is exchanged bi-directionally. But, Yablon does not explicitly teach whether or not the information indicates a type of subscriber data that the first telecommunication device wants to receive, as claimed by applicant. However, in a related field of endeavor, the ITU-T Recommendation teaches about a capability exchange wherein "the total capability of a terminal to receive and decode various signals is made known to the other terminal by transmission of its capability set (see entire document, particularly page 1, paragraphs 1-3). Motivation is same as provided in the rejection of claim 22.

As per claim 38: The preamble does not further limit the claim and is considered as an intended use. Regarding the features of claim 38, Yablon teaches:

a memory for storing subscriber data (see fig. 16; page 23, lines 5-9);

a facility for receiving device information of a further

telecommunications device (see fig. 16, steps 1 and 2; page 10-23);

a facility for transmitting particular subscriber data from the memory to the further telecommunications device depending on the device information received (see fig. 16, steps 1 and 2; page 23, lines 10-23). Fig. 16 includes the facility; and the particular subscriber data (e.g. video) is determined based on handshake information exchanged between the two devices. But, Yablon does not explicitly teach about information, which indicates components of subscriber data that the telecommunications device wants to receive, as claimed by applicant. However, this differential feature is taught by the ITU-T Recommendation (see page 1, paragraphs 1-5). Motivation is same as provided in the rejection of claim 22 above.

As per claim 40: The preamble does not further limit the claim and is considered as an intended use. Regarding claim 40, Yblon teaches:

a memory for storing device information (see fig. 16; page 23, lines 5-9);

a facility for transferring the device information from the memory to the further telecommunications device (see fig. 16; page 23, lines 5-9). Fig. 16 includes the facility/system.

a facility for receiving subscriber data from the further telecommunications device depending on the device information

transmitted (see fig. 16, the first and second steps; page 23, lines 10-23).

Fig. 16 includes the facility/system; and transfer of information (subscriber data) is based on the handshake result between the calling and called parties. Furthermore, since, the system is bi-directional, data would have been transmitted from either device and received by the other. But, Yablon does not explicitly teach about information, which indicates a type of subscriber data that a further telecommunications device wants to receive, as claimed by applicant. However, this differential feature is taught by the ITU-T Recommendation (see page 1, paragraphs 1-5). Motivation is same as provided in the rejection of claim 22 above.

As per claim 23: Yablon teaches a method, wherein at least one of the of the first and second telecommunications devices stores transmission information which indicates which subscriber data has been transmitted from the other respective telecommunications device (see page 23, lines 18-23; page 29, lines 9-20). The prior art identifies caller, electronic mail, text information, etc., which are transmission information. Furthermore, the preamble is considered as an intended use, since it does not further limit the claim.

As per claim 31: the feature of claim 31 is similar to the feature of claim 23. Hence, claim 31 is rejected on the same ground and motivation as claim 23.

As per claim 24: Yablon teaches a method, wherein the transmission information is transmitted from one telecommunications device to the other telecommunications device (see fig. 16; page 23, lines 10-15) with the subscriber data (see page 29, lines 9-20). The preamble is considered as an intended use.

As per claim 32: the feature of claim 32 is similar to the feature of claim 24. Hence, claim 32 is rejected on the same ground and motivation as claim 24.

As per claim 29: the ITU-T Recommendation teaches a method, wherein at least one of the first and second telecommunications devices stores release information which indicates which subscriber data should be transmitted to the respective other telecommunications device (see page 1, paragraphs 1-3). Storing "release information" is obvious from the fact that information, which indicates, which subscriber data should be transmitted to the respective other telecommunications device is exchanged.

As per claim 37: the feature of claim 37 is similar to the feature of claim 29. Hence, claim 37 is rejected on the same ground and motivation as claim 29.

As per claim 39: the feature of claim 39 is similar to the feature of claim 23, with the exception of the feature, "a further memory" (additional memory), which is provided by Yablon (see page 23, lines 5-9). The preamble of claim 39 is considered as an intended use. Hence, claim 39 is rejected on the same ground and motivation as claim 23.

Claims 25, 27 and 33, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claims 22 and 30 above, and further in view of Takahashi (US 5,592,546).

As per claim 25: while the preamble of claim 25 is considered as an intended use, the above references do not explicitly teach about a method, wherein the transmission information is assigned historical data, which references the transmitted subscriber data, as claimed by applicant. However, in a related field of endeavor (telecommunications device), Takahashi teaches about a telephone number retrieval function by using historical information, wherein the technique/method includes a memory for registering remote terminal name and telephone number pairs, in the order

of time the respective pairs have been registered, together with respective identification numbers relevant to the respective pairs (the identification numbers being assigned to the respective information pairs according to historical sequence in which the pairs are registered therein), including sort table for storing therein the above identification numbers in the alphabetical order with respective registered names; a transmission/reception history area for storing therein information including the remote terminal telephone numbers used for transmission/reception operations using memory dialing method and usage order table for storing information concerning the frequencies with which the respective pairs have been used in the transmission/reception (see fig. 2, particularly box 7; abstract; col. 3, lines 16-44; col. 10, lines 14-28). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references for the advantage of improving memory-dialing efficiency (see col. 3, lines 14-15), a feature which telephone devices are known to have.

As per claim 33: the feature of claim 33 is similar to the feature of claim 25. Hence, claim 33 is rejected on the same ground and motivation as claim 23.

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As per claim 27: while the preamble of claim 27 is considered as non-limiting, Takahashi teaches a method, wherein the subscriber data to be transmitted is referenced to current historical data (see col. abstract; col. 3, lines 20-44).

As per claim 35: the feature of claim 35 is similar to the feature of claim 27. Hence, claim 35 is rejected on the same ground and motivation as claim 27.

Response to Arguments

Applicant's arguments filed on 12/19/05 have been fully considered but they are not persuasive. Hereunder are provided applicant's argument and corresponding examiner's response.

Argument: with regard to all the pending claims, particularly claims 22, 30 and 38, applicant asserts 'the recited art, alone or in combination, fails to disclose the feature of "sending device information from the first telecommunications device to the second telecommunications device which indicates a type of subscriber data that the first telecommunication device wants to receive" as recited in independent claims 22 and similarly, in independent claims 30 and 38.'

Response: examiner respectfully disagrees with the argument. As an initial matter, the word wants, is not only a non-inventive word, it is a subjective word that attributes to a feeling/feelings. In the instant argument, claim or disclosure, the word does not have a

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meaning other than being an indicative of a capability of a communication device to receive data based on its ability/capability. To that effect, Yablon teaches a calling and recipient devices, either of which can be labeled as a first/or second device arbitrarily. Yablon's reference, with the deficiency of not being able exchange device capability, has been modified with that of ITU-T Recommendation. The ITU-T Recommendation asserts "the capability exchange procedures are intended to ensure that the only multimedia signals to be transmitted are those that can be received and treated appropriately by the receiving terminal. This requires that the capabilities of each terminal to receive and decode be known to the other terminal." This shows that a signal receiving device/terminal receives signals it can (want) process. When modified, the handshake process of Yablon can include the exchange of device capability information as taught by the ITU-T Recommendation. Hence, examiner did not find the argument persuasive.

Allowable Subject Matter

Claims 26, 28, 34 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Meless zewdu

M. Z.

Examiner

07 February 2006.


CHARLES APPIAH
PRIMARY EXAMINER